

PATENT & TRADEMARK  
OFFICE

STATEMENT UNDER 37 C.F.R. 1.28 (c)

FOR THE PURPOSE OF CORRECTING DEFICIENCY

NOV 13 95  
PATENT MAINTENANCE  
DIVISION  
IN THE PAYMENT OF MAINTENANCE FEES IN USP 4,621,077

FERNANDA M. FIORDALISI certifies as follows:

1. I am a patent attorney and my Registration No. in the United States Patent and Trademark Office is 20,938.

2. Enclosed herein is a check in the amount of \$1,800 to cover the deficiency in the amount of the Maintenance Fees paid in connection with USP 4,621,077 ("077"). The total amount of \$1,800 has been calculated as the sum of \$745.00 to correct the deficiency in connection with the maintenance fee due after three years and \$1,055 to correct the deficiency in the maintenance fee due after seven years from the date of issuance of the patent.

Fee Code

Fee Amount \$

3. The facts are as follows:

Fee Code

The Patent Application Serial No. 618,578 was filed on June 8, 1984 with an assignment from the inventors to Istituto Gentili S.P.A., (GENTILI) a corporation of Pisa, Italy. Correspondence between members of my firm and GENTILI were only through GENTILI's Italian Patent Attorneys, Studio Consulenza Brevettuale in Milan, Italy, GENTILI's Italian patent attorneys.

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1 183 745.00-EK  
1 184 1,055.00-EK

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4. At the time the application was filed, and as late as <sup>NOV 13 1995</sup> July, 1986, when the final fees were paid, GENTILI was a small business entity entitled to pay one half government fees. <sup>PATENT MAINTENANCE DIVISION</sup>

5. In 1989, I received instructions from Studio Consulenza Brevettuale to pay the maintenance fee due three years after the issuance of the patent. In 1994, I also received instructions from the same associate Studio Consulenza Brevettuale to pay the maintenance fee due seven years after the issuance of the patent.

6. On November 7, 1995, I was informed that in 1988 GENTILI granted a license to Merck & Co. on the '077, patent. By the terms of the license, GENTILI was responsible for maintaining the patent. I was not aware of, nor informed, that this license was in force at the time the prior maintenance fees were made.

7. In view of the fact that Merck & Co. is a large business entity, it is clear that the maintenance fees in 1989 and 1994 should have been paid at the rate due by a large business entity. Based on the above license agreement Merck & Co., had no duty to pay the maintenance fee.

8. I believe that the above errors occurred in good faith and were probably due to the failure of GENTILI to appreciate the requirements for a small business entity under United States law and also probably the poor knowledge of the English language by a clerical employee.

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DIVISION

9. I submit that there was no intent to deceive on the part of the  
licensor Instituto Gentili.

Fern H Fiordalisi

Fernanda M. Fiordalisi  
Reg. No. 20,938

Date: 11/10/95